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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,874	12/07/2001	Dean P. Swoboda	2251 (FJ-00-9)	7532

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EXAMINER
PATTERSON, MARC A

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-8

Office Action Summary	Application No.	Applicant(s)	
	10/004,874	SWOBODA ET AL.	
	Examiner	Art Unit	
	Marc A Patterson	1772	

-- The MAILING DATE of this communication appears on the c ver sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16,21-29 and 36-44* is/are pending in the application.

4a) Of the above claim(s) *38-44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16,21-29,36 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 38 – 44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the invention is directed to coatings comprising no mineral filler.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38 – 44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 112 second paragraph rejections of Claims 1 – 16 and 21 – 29, of record on 4 of the previous Action, are withdrawn.

The 35 U.S.C. 102(b) rejection of Claims 1 – 4, 10 – 13 and 16 as being anticipated by Shanton (U.S. Patent No. 5,776,619), of record on page 6 of the previous Action, is withdrawn.

The 35 U.S.C. 103(a) rejection of Claims 5 – 9, 14 – 15 and 21 – 29 as being unpatentable over Shanton (U.S. Patent No. 5,776,619), of record on page 8 of the previous Action, is withdrawn.

NEW REJECTIONS

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 16, 21 – 29 and 36 – 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to Claim 1, the phrase 'consisting essentially of' is indefinite as the claimed coatings also comprise a mineral filler. For purposes of examination, the phrase will be assumed to mean 'comprising.'

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1 – 16, 21 – 29 and 36 – 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanton (U.S. Patent No. 5,776,619).

With regard to Claims 1 – 3 and 36, Shanton discloses a paperboard food container (disposable tray; column 1, lines 11 – 17) comprising a paperboard blank (plate stock; column 4, lines 1 – 5) provided with a first coating layer comprising a styrene – butadiene resin (column 4, lines 30 – 36; column 5, lines 25 – 32) and a second top coating layer comprising an acrylic resin applied to the first layer (therefore a bilayer finish; column 4, lines 30 – 36); the food container exhibits a surface gloss (gloss; column 8, lines 5 – 14) of 74.8 gloss units at 75 degrees (therefore 40 at 60 degrees; column 8, lines 5 – 14). Shanton fails to disclose a coating comprising up to 2 pounds of mineral filler per 3,000 square feet. However, Shanton discloses a coating comprising

2.5 pounds of mineral filler per 3,000 square feet (the coatings are applied at a weight of 4 pounds per 3,000 square feet, and comprise 80 parts mineral filler per 120 parts of resin; column 4, lines 1 – 13; column 9, lines 9 – 20). Therefore, the amount of filler would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the amount of filler, since the amount of filler would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Shanton, in the absence of unexpected results. *In re Boesch and Slaney, 205 USPQ 215 (CCPA 1980).*

With regard to the aspect in Claim 1 of the container being 'formed in a heated die set,' and with regard to Claim16, the scope of the claims falls within the limitations of Shanton as discussed above. The method of application of the coating to the paperboard (product – by – process) is given little patentable weight. Applicant would need to demonstrate, by verified showing, the unexpected advantages accruing from the methods of coating application as claimed.

With regard to Claims 4 and 23, the styrene – butadiene compositions and acrylic resin compositions are aqueous emulsions (water – based varnish; column 6, lines 34 – 45).

With regard to Claim 10, Shanton teaches styrene – butadienes as the material of the first coating (column 5, lines 24 – 35). The claimed aspect of the coating comprising a 'carboxylated styrene – butadiene' therefore reads on Shanton.

With regard to Claims 11 – 13, the paperboard has a basis weight from 100 to 300 pounds per 3,000 square feet (column 4, lines 15 – 20).

With regard to Claims 5 – 9 and 24 – 29, Shanton fails to disclose a coating which is applied in an amount from 0.25 to 1.5 pounds per 3,000 square foot ream. However, Shanton discloses a coating which is applied in an amount from 4 to 12 pounds per 3,000 square foot ream (column 4, lines 1 – 13). Therefore, the coating weight would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the coating weight, since the coating weight would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Shanton. *In re Boesch and Slaney, 205 USPQ 215 (CCPA 1980).*

With regard to Claims 14 – 15, 21 – 22 and 37, the paperboard is provided with one or more clay coatings between the first coating and the paperboard (one or more coatings of the first coating is used, and the first coating comprises clay; column 4, lines 5 – 8 and lines 30 – 36). Shanton fails to disclose a paperboard which is sized with at least 4 to 15 pounds per 3,000 square feet of starch. However, Shanton discloses a paperboard which is sized with at least a fraction of a pound per 3,000 square feet of starch (the paperboard is sized with starch; column 6, lines 15 – 17). Therefore, the amount of starch would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the amount of starch, since the amount of starch would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Shanton. *In re Boesch and Slaney, 205 USPQ 215 (CCPA 1980).*

7. The declaration under 37 C.F.R. 1.132 filed July 3, 2003 is insufficient to overcome the 35 U.S.C. 102(b) rejection of Claims 1 – 4, 10 – 13 and 16 as being anticipated by Shanton (U.S. Patent No. 5,776,619) and 35 U.S.C. 103(a) rejection of Claims 5 – 9, 14 – 15 and 21 – 29 as being unpatentable over Shanton (U.S. Patent No. 5,776,619), as set forth in the previous Action because the evidence set forth therein fails to compare the claimed invention to the closest prior art of record.

The declaration provides data regarding the gloss values obtained for the claimed invention, and states that the values are greater than those of Shanton, but fails to provide a side – by – side comparision of the claimed invention and Shanton; the tables which provide exact numerical data contain data only for the claimed invention. Furthermore, Applicant indicates on page 5 that the gloss value of 74.8 (about 75) at 75 degrees which is disclosed by Shanton is equivalent to a gloss value of 40 (about 40) at 60 degrees, which reads on the claimed invention. Applicant describes the coating in Shanton for which the value is obtained as a 'very different system' from the claimed invention, but the coating is an acrylate – styrene – acrylonitrile (column 7, lines 18 – 37) which clearly reads on the claimed 'acrylic resin composition.'

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments regarding the 35 U.S.C. 112 second paragraph rejections of Claims 1 – 16 and 21 – 29, 35 U.S.C. 102(b) rejection of Claims 1 – 4, 10 – 13 and 16 as being anticipated by Shanton (U.S. Patent No. 5,776,619) and 35 U.S.C. 103(a) rejection of Claims 5 – 9, 14 – 15 and 21 – 29 as being unpatentable over Shanton (U.S. Patent No. 5,776,619), of record in the previous Action, have been considered and have been found to be persuasive. The

rejections are therefore withdrawn above. The new 35 U.S.C. 112 second paragraph rejection of Claims 1 – 16, 21 – 29 and 36 – 37 and 35 U.S.C. 103(a) rejection of Claims 1 – 16, 21 – 29 and 36 – 37 as being unpatentable over Shanton (U.S. Patent No. 5,776,619) above are directed to amended Claims 1 – 16 and 21 – 29 and newly submitted Claims 36 – 37.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold

Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.
Marc Patterson
Art Unit 1772

/Harold Pyon/
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772
9/20/03